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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,781	06/17/2000	GERALD SUGERMAN	GS1010	4332
21874	7590	11/22/2005	EXAMINER	
EDWARDS & ANGELL, LLP			JONES, DWAYNE C	
P.O. BOX 55874			ART UNIT	
BOSTON, MA 02205			PAPER NUMBER	
			1614	
DATE MAILED: 11/22/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/581,781	SUGERMAN, GERALD	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dwayne C. Jones	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04AUG2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 2,9 and 11-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,13 and 20-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 2,9 and 11,12, and 14-19 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-24 are pending.
2. Claims 1, 3-8, 10, and 20-24 are elected and rejected.
3. Claims 2, 9, and 11-19 are nonelected and withdrawn from consideration.

### ***Election/Restrictions***

4. Applicant's election with traverse of Group III, corresponding to claims 1, 3-8, 10, and 20-24, in the reply filed on August 4, 2005 is acknowledged. The traversal is on the ground(s) that there is no lack of unity for this claimed subject matter. This is not found persuasive because for example a prior art search for a hydroxyl-bearing unsaturated ester would not be required for a non-hydroxyl bearing unsaturated ester or an ether or an ether-ester or hydroxyl-bearing unsaturated ether-ester or a an ether.

The requirement is still deemed proper and is therefore made FINAL.

### ***Response to Arguments***

5. Applicant's arguments filed April 8, 2004 have been fully considered but they are not persuasive with respect to the rejection under 35 U.S.C. 103(a). Applicants present the following arguments. First, applicant attempts to argue that Blount et al. composition contains silicon and phosphorous, which the instant claims do not recite. First, applicant attempts to argue that Blount et al. composition contains silicon and phosphorous, which the instant claims do not recite. However, the instant claims are broad with terms such as "nonvolatile reactive amines", and contain the open-ended

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transitional word of comprising. Applicant recites the word "comprising", which is open-claim language. It is held that "the word 'comprising' incorporates additional steps of procedures and does not exclude materials or processes not recited in the claim".

*Gould v. Mossinghoff, Comr. Pats.*, (DCCD 1982) 215 USPQ 310.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 8, 10, 13, 20, 21, and 24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Riediker et al. of U.S. Patent No. 4,857,654. Riediker et al. teach of a composition of an amine (i.e., 1,4-butylenediamine of column 8, line 16), hydroxyl bearing, unsaturated esters, (i.e., triethylene glycol dimethacrylate of column 7, lines 58-59), and the oligol of triethylene glycol of column 7, line 43).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 3 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blount et al. of U.S. Patent No. 5,563,285. Blount et al. teach of a composition which contains the reactive amine of N-vinyl-2-pyrrolidone, the saturated glycol of diethyl ether, and castor oil. The following reference of Windholz et al. of The Merck Index, An Encyclopedia of Chemicals, Drugs, and Biologicals, 10<sup>th</sup> Edition is provided to show and provide evidence that Blount et al. does meet the embodiments of the instant claims. In addition, it is pointed out that MPEP 2131.01 clearly recites that an additional reference is added only to "[e]xplain the meaning of a term used in the primary reference; or . . . [to s]how that a characteristic not disclosed in the reference is inherent. Because Blount et al. specifically recite the presence of castor oil, which does render the instant claims as obvious, Windholz et al. is provided to show that the fatty acid composition of castor oil and is the triglyceride of inter alia, oleic and linoleic acids and which are fatty unsaturated acids, (see pages 265, 790, 979, 980 of Windholz et al.). Clearly, one having ordinary skill in the art would have been motivated to utilize any of the well known agents of the prior art especially because the instant claims are broad.

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Claims 1-3, 8, 10, 13, and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riediker et al. of U.S. Patent No. 4,857,654. Riediker et al. teach of a composition of an amine (i.e., 1,4-butyldiamine of column 8, line 16), hydroxyl bearing, unsaturated esters, (i.e., triethylene glycol dimethacrylate of column 7, lines 58-59), and the oligol of triethylene glycol of column 7, line 43). The selection of a known material based on its suitability for its intended use supported a prima facie case for obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). Accordingly, it would have been obvious to one having ordinary skill in the art to use the composition of Blount with an intended use recitation of using the claimed composition for latex. In addition, the courts have held, *In re Swinehart*, 169 USPQ 226, "a newly discovered property does not necessarily mean that the product is unobvious, since this property may be inherent in the prior art." Accordingly, the fact that when these known compounds are combined, as they were in the prior art, a toxic low environmental composition would be an inherent feature with this composition.

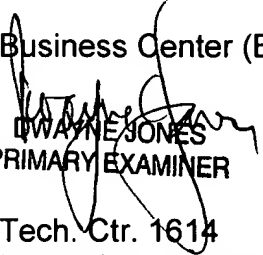
Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. C. Jones whose telephone number is (571) 272-0578. The examiner can normally be reached on Mondays, Tuesdays, Wednesdays, and Fridays from 8:30 am to 6:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, may be reached at (571) 272-0951. The official fax No. for correspondence is (571)-273-8300.

Also, please note that U.S. patents and U.S. patent application publications are no longer supplied with Office actions. Accordingly, the cited U.S. patents and patent application publications are available for download via the Office's PAIR, see <http://pair-direct.uspto.gov>. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications may be obtained from Private PAIR only. For more information about PAIR system, see <http://pair-direct.uspto.gov> Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll free).

  
DWAYNE JONES  
PRIMARY EXAMINER

Tech. Ctr. 1614  
November 14, 2005